

ESTTA Tracking number: **ESTTA520319**

Filing date: **02/07/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Garber Bros., Inc.		
Entity	Corporation	Citizenship	Massachusetts
Address	Route 139 Kay Way Stoughton, MA 02072 UNITED STATES		

Attorney information	David O. Johanson, Esq. Bingham McCutchen LLP One Federal Street Boston, MA 02110 UNITED STATES david.johanson@bingham.com Phone:617-951-8000
----------------------	--

Applicant Information

Application No	76705356	Publication date	01/08/2013
Opposition Filing Date	02/07/2013	Opposition Period Ends	02/07/2013
Applicant	U.S. PROPERTY MANAGEMENT ENTERPRISE INC. 7 MOSGROVE AVE ROSLINDALE, MA 02131 UNITED STATES		

Goods/Services Affected by Opposition


Class 035. All goods and services in the class are opposed, namely: Retail convenience store services and retail market store services featuring food, yogurt, sandwiches, soda, gum, candy, newspapers, magazines, lottery, and touristy stuff in the nature of t-shirts, hats, pens, mugs, maps, and directional maps of points of interest
--


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3882286	Application Date	10/20/2009
Registration Date	11/30/2010	Foreign Priority Date	NONE
Word Mark	BEANTOWN		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 030. First use: First Use: 1989/12/31 First Use In Commerce: 1989/12/31 Coffee, bakery goods, prepared sandwiches</p> <p>Class 035. First use: First Use: 1989/12/31 First Use In Commerce: 1989/12/31 Food kiosk services featuring coffee</p> <p>Class 037. First use: First Use: 1989/12/31 First Use In Commerce: 1989/12/31 Repair and maintenance of coffee brewing and dispensing machines; repair and maintenance of coffee brewing and dispensing supplies and accessories in the nature of coffee pots, air pots, coffee filters, portable coffee dispensers, dispensers for disposable coffee cups, lids, sugar, sweeteners and stirrers, and dispensers for cream and milk</p> <p>Class 043. First use: First Use: 1989/12/31 First Use In Commerce: 1989/12/31 Loaning and rental of food service equipment, namely, coffee brewing and dispensing machines; loaning and rental of food service equipment, namely, coffee brewing and dispensing supplies and accessories in the nature of coffee pots, air pots, portable coffee dispensers, dispensers for disposable coffee cups, lids, sugar, sweeteners and stirrers, and dispensers for cream and milk</p>

U.S. Registration No.	3991556	Application Date	10/20/2009
Registration Date	07/12/2011	Foreign Priority Date	NONE
Word Mark	BEANTOWN COFFEE		
Design Mark			
Description of Mark	<p>The mark consists of the stylized wording "BEANTOWN COFFEE" and a design comprised of an incomplete diamond with a border and with a depiction of a coffee cup with steam superimposed on it; at the bottom of the incomplete diamond, and overlapping it, is a rectangle with a border; the wording "BEANTOWN" is displayed across the depiction of a coffee cup in the incomplete diamond and the wording "COFFEE" is displayed in the rectangle.</p>		
Goods/Services	Class 030. First use: First Use: 1989/12/31 First Use In Commerce: 1989/12/31		

	<p>Coffee</p> <p>Class 035. First use: First Use: 1989/12/31 First Use In Commerce: 1989/12/31 Food kiosk services featuring coffee</p> <p>Class 037. First use: First Use: 1989/12/31 First Use In Commerce: 1989/12/31 Repair and maintenance of coffee brewing and dispensing machines; repair and maintenance of coffee brewing and dispensing supplies and accessories in the nature of coffee pots, thermal insulated pump pots, coffee filters, portable coffee dispensers, dispensers for disposable coffee cups, lids, sugar, sweeteners and stirrers, and dispensers for cream and milk</p> <p>Class 043. First use: First Use: 1989/12/31 First Use In Commerce: 1989/12/31 Loaning and rental of food service equipment, namely, coffee brewing and dispensing machines; loaning and rental of food service equipment, namely, coffee brewing and dispensing supplies and accessories in the nature of coffee pots, thermal insulated pump pots, portable coffee dispensers, dispensers for disposable coffee cups, lids, sugar, sweeteners and stirrers, and dispensers for cream and milk</p>
--	---

Attachments	<p>77853012#TMSN.jpeg (1 page)(bytes)</p> <p>77853050#TMSN.jpeg (1 page)(bytes)</p> <p>Notice of Opposition.pdf (10 pages)(455972 bytes)</p>
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/david johanson/
Name	David O. Johanson, Esq.
Date	02/07/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD**

In re Application Serial No. 76/705,356
Published in the Official Gazette of January 8, 2013

Mark: BEANTOWN EXPRESS (and Design)

Application Filing Date: November 16, 2010

Garber Bros., Inc.,

Opposer,

v.

U.S. Property Management Enterprise Inc.,

Applicant.

NOTICE OF OPPOSITION

Opposer, Garber Bros., Inc. ("Opposer") believes that it will be damaged by the issuance of a registration for the mark BEANTOWN EXPRESS (and Design) (the "Applicant's Mark"), with respect to the services in international class 35 as applied for in Application Serial No. 76/705,356, as filed by U.S. Property Management Enterprise Inc. ("Applicant"), and hereby opposes the same.

As grounds for this Opposition, Opposer alleges as follows:

1. Opposer is a corporation organized and existing under the laws of the Commonwealth of Massachusetts, with a principal place of business at Route 139, Kay Way, Stoughton, Massachusetts 02072.

2. Applicant is, upon information and belief, a corporation organized and existing under the laws of the Commonwealth of Massachusetts, with a principal address at 7 Mosgrove Avenue, Roslindale, Massachusetts 02131.

3. Since at least as early as 1989, Opposer has operated food kiosks under the marks BEANTOWN and BEANTOWN COFFEE (collectively, the “Marks”), and has offered repair, maintenance, loaning and rental services for food service equipment in connection therewith.

4. Since at least as early as 1989, Opposer has used the Marks in connection with a variety of staple foods, namely, coffee, sandwiches and bakery goods.

5. Since Opposer’s initial use of its Marks, Opposer has made consistent and substantial investments in advertising and promoting the goods and services it provides under its Marks, with the result that consumers have come to know and recognize Opposer’s Marks, and associate the same with Opposer and/or the goods and services provided by Opposer. Opposer has built up extensive goodwill in connection with the provision of food, drinks and food services under its Marks.

6. Opposer is the owner of the following United States Trademark Registrations:

- Reg. No. 3,882,286 for the mark BEANTOWN, for use in connection with “*coffee, bakery goods, prepared sandwiches*” in international class 30, “*food kiosk services featuring coffee*” in international class 35, “*repair and maintenance of coffee brewing and dispensing machines; repair and maintenance of coffee brewing and dispensing supplies and accessories in the nature of coffee pots, air pots, coffee filters, portable coffee dispensers, dispensers for disposable coffee cups, lids, sugar, sweeteners and stirrers, and dispensers for cream and milk*” in international class 37, and “*loaning and rental of food service equipment, namely, coffee brewing and dispensing machines; loaning and rental of food service equipment, namely, coffee brewing and dispensing supplies and accessories in the nature of coffee pots,*

air pots, portable coffee dispensers, dispensers for disposable coffee cups, lids, sugar, sweeteners and stirrers, and dispensers for cream and milk” in international class 43; and

- Reg. No. 3,991,556 for the mark BEANTOWN COFFEE (and Design), for use in connection with “*coffee*” in international class 30, “*food kiosk services featuring coffee*” in international class 35, “*repair and maintenance of coffee brewing and dispensing machines; repair and maintenance of coffee brewing and dispensing supplies and accessories in the nature of coffee pots, thermal insulated pump pots, coffee filters, portable coffee dispensers, dispensers for disposable coffee cups, lids, sugar, sweeteners and stirrers, and dispensers for cream and milk*” in international class 37, and “*loaning and rental of food service equipment, namely, coffee brewing and dispensing machines; loaning and rental of food service equipment, namely, coffee brewing and dispensing supplies and accessories in the nature of coffee pots, thermal insulated pump pots, portable coffee dispensers, dispensers for disposable coffee cups, lids, sugar, sweeteners and stirrers, and dispensers for cream and milk*” in international class 37.

7. Notwithstanding Opposer’s prior rights in and to the BEANTOWN and BEANTOWN COFFEE Marks, on or about November 16, 2010, Applicant filed a federal intent-to-use-based registration application with the U.S. Patent and Trademark Office (the “PTO”) for the mark BEANTOWN EXPRESS (and Design) for use in connection with “*retail convenience market services for providing food and drink, newspapers, magazine articles, coffee, gum etc.*” These services were subsequently amended to “*retail convenience store services and retail market store services featuring food, yogurt, sandwiches, soda, gum, candy, newspapers, magazines, lottery, and touristy stuff in the nature of t-shirts, hats, pens, mugs, maps, and directional maps of points of interest*” in international class 35 (collectively, the “Applicant’s Services”). The PTO assigned Serial No. 76/705,356 to this filing (the “Application”).

8. An Office Action issued for the Application on March 1, 2011, which cited a Section 2(d) likelihood of confusion refusal based on Applicant’s U.S. Reg. No. 3,882,286

for the mark BEANTOWN and Applicant's U.S. Application Serial No. 77/853,050 for the mark BEANTOWN COFFEE (and Design). Application Serial No. 77/853,050 has since registered, and was assigned U.S. Reg. No. 3,991,556.

9. On May 18, 2011, Applicant's President, George Gregoriadis filed a Response to the Office Action, in which he submitted an unsigned, rudimentary, one-sentence "Letter of Consent" alleging that the Opposer had given its consent to his use and registration of the Applicant's Mark.

10. At no point prior to submitting the "Letter of Consent" did Mr. Gregoriadis ever contact the Opposer to seek consent or otherwise inform Opposer of its plans to use and register the Applicant's Mark.

11. On June 3, 2011, a Second Office Action issued due to the fact that the Applicant failed to sign the Response.

12. On or about July 7, 2011, Mr. Gregoriadis sent to Opposer a request for its consent to his registration of the Applicant's Mark, and included the "Letter of Consent" for the Opposer's execution.

13. On or about July 22, 2011, Opposer, through its attorneys, replied to Mr. Gregoriadis with a letter informing him of the Opposer's rights in its Marks, denying him consent to use or register the Applicant's Mark, and demanding that he abandon the Application and cease any use of a mark comprised of or incorporating the term BEANTOWN for the same or related goods and/or services as those provided by the Opposer under its Marks.

14. Despite receiving clear proof of the Opposer's rights in its Marks and notice that the Applicant's Mark infringed on these rights, on September 6, 2011, the Applicant filed a Response to the Second Office Action, in which he again included a copy of the "Letter of Consent." The "Letter of Consent" submitted with the Response had been executed by Mr. Gregoriadis, but was not executed by the Opposer, and included the following handwritten statement: "NO BEANTOWN COFFEE WILL BE SERVED OR BREWED." The "Letter of Consent" was subsequently rejected by the Examining Attorney because it lacked the Opposer's signature.

15. After submitting two more Responses in which he failed to overcome the Examining Attorney's Section 2(d) likelihood of confusion refusal, Mr. Gregoriadis failed to file a Response by the October 9, 2012 deadline. As a result, a Notice of Abandonment issued for the Application on November 9, 2012.

16. On or about November 14, 2012, Mr. Gregoriadis filed with the PTO a Petition to Revive the Application, which Petition was granted. Mr. Gregoriadis also filed at this time an amendment to the Application, which addressed outstanding issues regarding the identification of services in the Application and the description of the Applicant's Mark. The amendment did not address the outstanding Section 2(d) likelihood of confusion refusal based on Opposer's Marks.

17. On December 3, 2012, newly-assigned Examining Attorney Emily Carlsen issued an Examiner's Amendment for the Application, which amended in the Application the identification of services and the description of the mark. However, the Examiner's Amendment made no mention of either a continuation or a withdrawal of the Section 2(d)

likelihood of confusion refusal. Despite that, the Application was published in the Official Gazette on January 8, 2013.

18. Upon information and belief, Applicant's BEANTOWN EXPRESS (and Design) application was filed with the PTO with knowledge of Opposer's prior use of and rights in its Marks with similar and related goods and services.

19. Applicant's use of a confusingly similar mark in connection with similar and related services is likely to cause significant confusion as to source, sponsorship, and affiliation and will falsely suggest a connection with Opposer.

GROUND I – LIKELIHOOD OF CONFUSION

20. Opposer hereby incorporates by reference the allegations of Paragraphs 1 through 19 hereof as if fully set forth herein.

21. Registration by Applicant of the Applicant's Mark for use in connection with the Applicant's Services would seriously damage Opposer and should be refused because use and/or registration of the Applicant's Mark is likely to cause confusion in the minds of the public and deceive purchasers. The public, upon seeing Applicant's Mark in connection with Applicant's Services, would believe that such services originate with, or have some connection with, the Opposer. Opposer avers that Applicant's use of said mark interferes with Opposer's use of its Marks, and will and does impede Opposer in the free use of said Marks, and that registration of the Applicant's Mark by Applicant for use in connection with the Applicant's Services will seriously damage the Opposer under 15 U.S.C. §1052(d).

22. Applicant's Mark, when used in connection with the Applicant's Services, is also likely to cause confusion, deception, and mistake with Opposer's Marks because

Applicant's Mark is very visually and audibly similar to Opposer's Marks. Specifically, Applicant's Mark, BEANTOWN EXPRESS, incorporates the entirety of the Opposer's BEANTOWN trade name and trademark, as well as the dominant "BEANTOWN" portion of the Opposer's BEANTOWN COFFEE trade name and trademark. The Applicant's use of the term "EXPRESS" does not serve to distinguish the Applicant's Mark from the Opposer's Marks, because the term "BEANTOWN" is featured as the dominant portion of both parties' marks. In addition, the Applicant's use of the descriptive word "EXPRESS" only serves to strengthen the connection to the Opposer and its Marks, as it will lead consumers to believe that Applicant's Services are provided as an expeditious ("express") branch of the Opposer's business operations.

23. Applicant's Mark, when used in connection with the Applicant's Services, is also likely to cause confusion, deception, and mistake with Opposer's Marks because Applicant's Mark is used on and with services (namely, retail services featuring food, yogurt, sandwiches, soda, gum, candy, newspapers, magazines, and lottery items) that are identical or highly related to certain of the goods and the food kiosk services provided under Opposer's BEANTOWN and BEANTOWN COFFEE trade names and trademarks, since Opposer's registrations identify food and drink items (sandwiches, bakery items and coffee). Moreover, the items featured in the Applicant's Services are identical or highly related to the items sold by the Opposer in connection with its food kiosk services.

24. Applicant's Mark, when used in connection with the Applicant's Services, is also likely to cause confusion, deception, and mistake with Opposer's Marks as the services provided by the parties in connection with their respective marks are both likely to be offered in similar and/or related channels of trade, and to the same and/or similar customers,

which customers are ordinary consumers of inexpensive items, who are not cautious or discriminating about their purchases. Therefore, the Applicant's Services are likely to be mistakenly viewed by consumers as a natural expansion of Opposer's Goods. The overlap of the respective parties' customers, markets and channels of trade is all the more likely based on the fact that Opposer and the Applicant are both based in Massachusetts.

25. Registration of Applicant's Mark for use in connection with the Applicant's Services would be prima facie evidence of rights of Applicant under 15 U.S.C. § 1057(b), to the detriment of Opposer's rights in its BEANTOWN and BEANTOWN COFFEE trade names and trademarks.

26. Pursuant to 15 U.S.C. §1063(a), as amended, Opposer believes it will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the infringing use of the Applicant's Mark sought to be registered, and will give colorable exclusive statutory rights to Applicant in violation and derogation of prior and superior statutory and common law rights of Opposer.

WHEREFORE, Opposer, Garber Bros., Inc., believes and avers that it will be damaged by said registration and prays that registration of the BEANTOWN EXPRESS (and Design) mark for use in connection with the goods shown in Application Serial No. 76/705,356, filed by Applicant, be refused, and that this Opposition be sustained.

The filing fee for this Notice of Opposition in the amount of \$300.00 is enclosed, for Opposer's opposition to registration of the mark BEANTOWN EXPRESS (and Design) in one class.

Please recognize as attorneys for Opposer in this proceeding David O. Johanson, Rachelle A. Dubow, Joshua M. Dalton and Devon R. Sparrow (members of the Bar of the Commonwealth of Massachusetts) and the firm of Bingham McCutchen LLP, One Federal Street, Boston, Massachusetts 02110.

All correspondence should be addressed to David O. Johanson, Esq., of Bingham McCutchen LLP, One Federal Street, Boston, Massachusetts 02110.

Respectfully submitted,

A handwritten signature in blue ink, appearing to read "David O. Johanson", is written over a horizontal line.

David O. Johanson
Rachelle A. Dubow
Joshua M. Dalton
Devon R. Sparrow
BINGHAM McCUTCHEN LLP
One Federal Street
Boston, MA 02110
(617) 951-8000

Dated: February 7, 2013

Attorneys for Opposer,
GARBER BROS., INC.

CERTIFICATE OF SERVICE

This is to certify that a copy of the Notice of Opposition, was mailed on February 7, 2013 by first-class mail, postage prepaid to the Applicant, in an envelope addressed as follows:

George Gregoriadis
U.S. Property Management Enterprise Inc.
7 Mosgrove Avenue
Roslindale, Massachusetts 02131

Dated: February 7, 2013



David O. Johanson, Esq.
Attorney of Record, Massachusetts Bar Member